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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,446	03/25/2004	James Huang	040139	4859

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EXAMINER	
PIZIALI, ANDREW T	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,446	HUANG ET AL.	
	Examiner	Art Unit	
	Andrew T Piziali	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/5/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,162,149 to Reaney.

Regarding claims 1-3 and 6, Reaney discloses an asymmetric porous PTFE membrane for clothing comprising a dense skin layer and a continuously foamed porous layer (see entire document including column 1, lines 5-55 and column 2, lines 35-61).

Regarding the currently claimed contact angle of water to the surface of the skin layer and the claimed diffuse reflectance of light of the skin layer, considering the identical skin layer of Reaney, a thermally treated dense skin layer of PTFE (column 4, lines 20-27), compared to the currently claimed skin layer, it appears that the skin layer of Reaney possesses the currently claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and

prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ.431 (CCPA 1977).

Regarding claims 2 and 6, Reaney discloses that the porous PTFE membrane may be obtained according to the teachings of USPN 3,953,566 and USPN 4,187,590 (column 3, lines 57-64). The cited documents obtain porous PTFE by drawing in a biaxial direction.

Regarding claims 3 and 6, Reaney discloses that the porous PTFE may have a thickness of between 10 and 100 μm (column 3, lines 57-64).

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,749,586 to Abe et al. (hereinafter referred to as Abe).

Regarding claims 1 and 2, Abe discloses an asymmetric porous PTFE membrane comprising a dense skin layer and a continuously foamed porous layer (see entire document including column 4, lines 8-55).

Regarding the currently claimed contact angle of water to the surface of the skin layer and the claimed diffuse reflectance of light of the skin layer, considering the identical skin layer of Abe, a thermally treated dense skin layer of PTFE (column 4, lines 45-48), compared to the currently claimed skin layer, it appears that the skin layer of Abe possesses the currently claimed properties.

Regarding claim 2, Abe discloses that the porous PTFE membrane may be obtained by drawing (column 1, lines 55-57 and column 4, lines 16-25). Although Abe does not specifically mention biaxial drawing, it is the examiner's position that the article of the applied prior art is identical to the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Claim Rejections - 35 USC § 103

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,162,149 to Reaney as applied to claims 1-3 and 6 above, and further in view of USPN 4,863,788 to Bellairs et al. (hereinafter referred to as Bellairs).

Reaney discloses that the invention relates to breathable waterproof fabrics (column 1, lines 5-30) and that the porous PTFE may be adjacent a fabric (column 3, lines 12-17), but does not mention specific fabrics. Bellairs discloses that it is known in the art of breathable

waterproof fabrics to use woven and nonwoven fabrics of polyester, cotton, or the like (column 3, lines 53-68). Considering that Reaney is silent with regards to specific materials, it would have been necessary and thus obvious to look to the prior art for conventional materials. Bellairs provides this conventional teaching showing that it is known in the art to use woven and nonwoven fabrics of polyester, cotton, or the like. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric from woven or nonwoven fabrics of polyester, cotton, or the like, as taught by Bellairs, motivated by the expectation of successfully practicing the invention of Reaney.

Conclusion

6. The following patents are cited to further show the state of the art with respect to drawing a porous PTFE membrane:

USPN 3,953,566 to Gore

USPN 4,187,590 to Harris et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/25/05

atp

ANDREW T. PIZIALI
PATENT EXAMINER